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OFFICE OF PETITIONS

In re Application of :
Co et al. : DECISION ON APPLICATION
Application No. 09/626,731 : FOR
Filed: July 27, 2000 : PATENT TERM ADJUSTMENT
Atty Docket No. GNN-5315DV2 :

This is a decision on the paper styled "STATEMENT REGARDING PATENT TERM ADJUSTMENT" filed June 15, 2005. Applicants agree that the initial determination of patent term adjustment under 35 U.S.C. 154(b) is zero (0) days. Applicants request that the initial determination of patent term adjustment of zero (0) days, include a period of adjustment increased by twenty-five (25) days, and a period of reduction decreased by eleven (11) days and increased by one hundred fifty (150) days.

The application for patent term adjustment is **GRANTED** to the extent indicated herein.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is zero (0) days, including 0 days of Office delay and 233 days of applicant delay. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On April 21, 2005, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment

(PTA) to date is 0 days. On June 15, 2005, applicants timely¹ submitted an application for patent term adjustment. First, applicants dispute the reduction of 11 days associated with the receipt of their response on January 7, 2002, to the restriction requirement mailed September 27, 2001. Applicants assert that their response was filed on November 7, 2001, and thus, there should be no reduction for replying outside of the three-month period. Second, applicants assert that since their response was filed on November 7, 2001, then a period of adjustment of 25 days should be entered for the Office taking until April 1, 2002 to respond. Third, applicants disclose that a period of reduction of 150 days, not 28 days, should be entered for their delay in responding to the final Office action mailed June 3, 2004. Applicants state that the date of filing of a request for continued examination (RCE) on January 31, 2005 should be used in calculating the delay, not the date of filing of a notice of appeal on October 1, 2004.

It appears that the patent issuing from the application is not subject to a terminal disclaimer.

As to the reduction of 11 days, it has been concluded that the reduction should be removed for reasons other than those stated by applicants. By Notice dated January 15, 2002, it was provided that:

If a reply to an Office action or notice was mailed on or after October 13, 2001 and no later than December 1, 2001 (as shown on a certificate of mailing under 37 CFR 1.8), and the applicant is otherwise entitled to patent term adjustment (or additional patent term adjustment) but for the fact that there was a reduction of such patent term adjustment under 35 U.S.C. 154(b)(2)(C)(ii) and 37 CFR 1.704(b) due to the receipt of such reply by the Office more than three business days after the date indicated on the certificate of mailing, the Office will consider the USPS mail situation discussed in this notice to constitute a sufficient showing that, in spite of all due care, the applicant was unable to reply to the Office action or notice within three months of the date of mailing of the Office action or notice. In this situation, the Office will, subject to the conditions set forth below, reinstate

¹ Office records indicate that the Issue Fee payment was received on July 20, 2005.

a period equal to the period beginning on the date that is four business days after the date indicated on the certificate of mailing on the reply and the date of receipt (37 CFR 1.6) of the reply in the Office up to a maximum of three months.

The relevant reply was mailed on November 7, 2001, as shown by the certificate of mailing under § 1.8 thereon. However, the patent term adjustment was reduced by 11 days because the response was not received in the Office until January 7, 2002.

Thus, it is concluded that the Notice dated January 15, 2002 is applicable to this situation; in spite of all due care, the applicants were unable to reply to the Restriction Requirement within three months of the date of mailing of the notice, September 27, 2001. It is further concluded that applicants have met the other conditions set forth in the Notice for reinstatement of patent term. In this instance, the period of reinstatement is from November 14, 2001, the day that is four business days (excluding federal holidays) after November 7, 2001, to January 7, 2002, the date of receipt of the reply. This period constitutes more than 11 days, and thus, applicants are entitled to reinstatement of the entire period of reduction of 11 days.

However, applicants are not entitled to a period of adjustment for Office delay in taking action in response to the response received January 7, 2002. In this regard, applicants' attention is directed to 37 CFR 1.703(f), which provides that "[t]he date indicated on any certificate of mailing or transmission under § 1.8 shall not be taken into account in this calculation" of patent term adjustment. See also, Comment 10, *Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term; Final Rule*, 65 Fed. Reg. 54366 (September 18, 2000). Thus, the date of January 7, 2002, not the certificate of mailing date of November 7, 2001, is used in determining Office delay. As the non-final Office action was mailed in response to, and within four months of, receipt of the response received January 7, 2002, there is no basis for entering a period of adjustment.

Finally, as to entering an additional reduction of 150 days, applicants are incorrect. Pursuant to § 1.704(b), a period of reduction of 28 days was properly entered for applicant delay in first filing in response to the final Office action mailed June 3, 2004, a response in compliance with 1.113(c) on October 1,

2004. Furthermore, the filing of a request for continued examination within the period for taking action after the filing of a notice of appeal does not cause entry of an additional period of reduction.

For the same reasons, the entry of a period of reduction of 170 days associated with applicants' filing of a request for continued examination (RCE) on June 26, 2003 is incorrect. In response to the final rejection mailed October 7, 2002, applicants filed a response in compliance with 1.113(c), a Notice of Appeal on April 7, 2003. Thus, the period of reduction is 90 days, counting the number of days in the period beginning on January 8, 2003 and ending on April 7, 2003.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is zero (0) days (including 0 days of Office delay and 233 days of applicant delay).

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The Office will forward the file to the Office of Patent Publication so that the patent can be issued in a timely manner.

Telephone inquiries specific to this matter should be directed to Nancy Johnson, Senior Petitions Attorney, at (571) 272-3219.

Karin Ferriter
Karin Ferriter
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

Attachment: Copy of Revised PAIR Screen